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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/759,530
Filing Date: January 16, 2001
Appellant(s): MAUBRU ET AL.

Louis M. Troilo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 5, 2006 appealing from the Office action mailed December 21, 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

| | | |
|---------------------|---------------|-------------------|
| US Patent 5,482,704 | Sweger et al. | January 9, 1996 |
| US Patent 6,277,893 | Babenko | August 21, 2001 |
| US Patent 5,919,438 | Saint-Leger | July 6, 1999 |
| US Patent 5,720,964 | Murray | February 24, 1998 |

(9) Grounds of Rejection***Claim Rejections 35 U.S.C 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 12, 14, 16-18, 20-22 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweger et al. (US 5,482,704, of record) and Babenko (US 6,277,893) in view of Saint-Leger (US 5,919,438, of record), and Murray (US 5,720,964, of record).

3. Sweger et al. teach the usefulness of the amphoteric starch herein employed in cosmetic composition. The starch derivatives may be used as thickener or emulsion stabilizer, they provide cosmetic composition with excellent aesthetic properties of skin feel and appearance. See, particularly, col. 1, line 20 to col. 2, line 33. The starch derivatives may be employed in various cosmetic compositions, including skin care creams and lotion, the cosmetic composition

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may comprise various conventional cosmetic ingredients. The amounts of the starch derivatives employed are depending on the type of cosmetic compositions, but generally in the range of 0.1% to 20%. See, particularly, col. 4, line 39 to col. 6, line 40. The starch derivatives are superior to Carbopol (a conventional thickener and emulsion stabilizer) in respect of thickening and emulsion stabilizing properties. See, particularly, columns 8-9. Babenko teaches particularly a stable oil-in-water emulsion for use in cosmetic composition comprising the starch derivatives herein as emulsifier. The emulsion is particularly useful in compositions such as creams, lotions, antiperspirants, make-up products, sunscreens, shampoos and body cleansing products. See, particularly, the abstract, column 5, lines 20-40. Dimethicone, a polydimethylsiloxane is particularly useful in making the emulsion. See, particularly, col. 6, 10-32.

4. The primary references do not teach expressly a composition comprising each and every cosmetic ingredient herein listed, alkyl ether sulfate, the particular cationic polymer, polydimethylsiloxane, and coconut monoisopropanolamide, and without fatty acid soap.

5. However, Murray teaches a shampoo composition comprising alkyl ether sulfates, e.g., sodium lauryl ether sulfate, silicone emulsion, cationic polymers, such as polymer JR 400, and a thickener. See, particularly, the abstract, col. 3, line 36 to col. 6, line 45. Saint-Leger teaches that coconut monoisopropanolamide is particularly useful in shampoo composition, particularly with alkyl ether sulfate. See, particularly, the example 1, in col. 4. Further, none of the primary references require the present of fatty acid soap when amphoteric starch is used.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the starch derivatives herein as emulsion stabilizer or thickener (as taught by Sweger et al. and Babenko) to make a cosmetic

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emulsion composition, and incorporate the conventional cosmetic ingredients herein disclosed to formulate a particular cosmetic composition, such as shampoo, and without using fatty acid soap.

A person of ordinary skill in the art would have been motivated to employ the starch derivatives herein as emulsion stabilizer or thickener (as taught by Swagger et al. and Bambino) to make a cosmetic emulsion composition, and incorporate the conventional cosmetic ingredients herein disclosed to formulate a particular cosmetic composition, such as shampoo, and without using fatty acid soap because the starch derivatives have excellent aesthetic properties of skin feel and appearance, and are superior to conventional thickener or emulsion stabilizer. The employment of the particular ingredients herein, i.e., alkyl ether sulfate, the particular cationic polymer, polydimethylsiloxane, and coconut monoisopropanolamide, in a cosmetic composition, e.g., shampoo, is obvious to one of ordinary skill in the art because all these ingredients are old and well-known cosmetic ingredients, particularly in shampoo composition.

(10) Response to Argument

Appellants argues that the prior art does not teach or suggest all claim Elements. Particularly, appellants contend that the prior art does not teach or suggest “free of fatty acid soaps.” Appellants’ arguments based on the fact that one examples disclosed by Sweger employs fatty acid soaps.

6. The arguments are not probative. As to the teaching of Sweger et al., or Bakenko et al., the examiner contends that one of ordinary skill in the art would have not review the particular examples as the full scope of teachings in Sweger et al. There is no suggestion in Sweger et al. or Bakenko et al., that the cosmetic care composition disclosed therein has to have fatty acid soaps as detergents. See, particularly, the abstract, columns 5-6 and the claims in Sweger et al. Further,

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it is well-settled that "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See, also MPEP 2123.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion and motivation are found in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Sweger et al. teach many superior properties of the amphoteric starch herein employed in cosmetic composition. The secondary references teach the other ingredients herein employed are old and well-known cosmetic ingredients functioning as herein employed. One of ordinary skill in the art would have been motivated to incorporate the amphoteric starch in a cosmetic composition and enjoy an reasonable expectation of superior properties disclosed by the primary reference, absent evidence to the contrary. The motivation, or desirability, to employ the amphoteric starch in cosmetic composition is clear and convincing. One of ordinary skill in the art would have been motivated to combine not merely because that each and every ingredients herein are known cosmetic ingredients, but to take advantage of the superior cosmetic properties of the amphoteric starch herein.

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8. Applicants further argue the rejections erred in picking and choosing with respect to other ingredients recited in the dependent claims. The arguments have been fully considered, but are found unpersuasive. Absent evidence showing results that are unexpected and unobvious to one of ordinary skill in the art, there is no issue for picking and chose. Selecting a cosmetic ingredient from the well-known cosmetic ingredients for the known function through routine experiments is within the skill of artisan, absent evidence to the contrary.

9. Appellants argue that “especially in view of well-established case law holding it “impermissible within the framework of Section 103 to *pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art” In re Wesslau, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). In essence, the Office's rejection is based on selective picking and choosing from each of several references in order to arrive at the claimed invention, while impermissibly ignoring the art as a whole.”

10. Wesslau is misused herein, unlike the current situation, In Wesslau, the cited references lead away from the claimed invention. *“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The Anderson patent is the only reference before us which recognizes the desirability of producing polyethylene with a narrow molecular weight distribution range. Were one to follow the teachings of that patent in its entirety, he would be led to believe that control over the molecular weight distribution of polyethylene was gained*

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independently of the catalyst system, a belief untenable in light of appellant's disclosure." As discussed above, the cited references herein as a whole, do not particular require fatty acid soaps.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellants' citation of *The Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 U.S.P.Q.2d 1923 (Fed. Cir. 1990) is improper herein. Particularly, as appellants recognized, "the Court held that although all four of Johnson's claimed components were known, "[w]hat was not known or suggested, however, was the composition that resulted from the combination of those components, and its *unique properties*." (emphasis added). As repeatedly argued by the examiner on the record, there are no unique, unexpected, or unobvious properties residing in the claimed invention. No prima facie case of unexpected benefit commensurate in scope with claimed invention has been established on the record.

11. As stated in *In re O'Farrell*, 7 U.S.P.Q. 2d 1673 (CAFC 1988) "Rejection of patent application *cannot be* overturned on ground that examiner and Board of Patent Appeals and Interferences applied impermissible "obvious to try" standard, since assignment of error for application of such standard usually occurs when invention is made by varying all parameters or trying each of numerous choices *until successful without indication in prior art as to which*

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parameters were critical or which choices were likely to be successful, or when invention is made by exploring promising new technology or general approach with only general guidance from prior art as to particular form of claimed invention or how to achieve it, and since neither situation is present in instant case.” (Emphasis added). In the instant situation, as in O’Farrell, there is no such critical parameter that is not obvious at the time the claimed invention was made. Applicants have failed to point out (and the examiner could not find) any successful story residing in the claimed invention, nor have applicants specified the critical parameter(s) that make the claimed invention patentable distinct from the prior art.

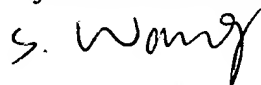
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

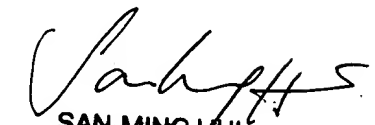
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Shengjun Wang



SHENGJUN WANG
PRIMARY EXAMINER

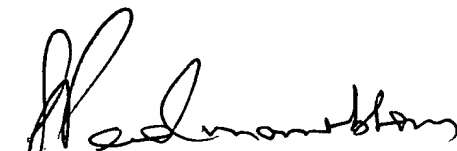


SAN-MING HUI
PRIMARY EXAMINER

Conferees:

Sreeni Padmanabhan

San-ming Hui



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER